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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

KIRIL A. PANDELISEV

Serial No. 09/587,318

Art Unit: 3762

Filed: June 5, 2000

Examiner: O. Khan

For: MULTIPLE SELECTABLE FIELD/CURRENT-VOLTAGE PADS HAVING
INDIVIDUALLY POWERED AND CONTROLLED CELLS

TECHNOLOGY CENTER R3700

JUN 12 2002

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RESPONSE

To the Commissioner of Patents and Trademarks

Sir:

In response to the Office Action dated May 8, 2002, kindly consider the following:

Applicant provisionally elects Group I drawn to the healing cell apparatus, with traverse. Claims 1-41 read on the elected species.

Reconsideration and withdrawal of the election requirement are requested.

The claims of Groups I, II, III, and IV do not relate to materially different apparatuses or processes. The apparatus defined by Group I relates to the apparatuses of Groups II and III used for the method, per se, described in the claims of Group IV.

The claims are not related to materially different processes that would require different apparatuses, nor can they be used to practice a different process than that intended and claimed.

For instance, the claims clearly define the apparatus of Group I, Group II and Group III as being part of the method of Group IV. Such a device cannot have the different applications contemplated by the examiner.

Hence, the Examiner should kindly withdraw the restriction and consider all the claims: 1-83.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out "independent" means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon a holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed
inventions:

are able to support separate patents and they are ...
distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

If the search and examination of an entire application can
be made without serious burden, the examiner must examine it
on the merits, even though it includes claims to distinct or
independent inventions.

So that Section 803 makes its point clearly, the serious

burden requirement is repeated under the title:

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

Section 803 goes on to state that there are two criteria for

a restriction requirement: one, that the inventions must be
distinct as claimed; and two, that there must be a serious burden
on the examiner if restriction were not required.

Section 803 further states under GUIDELINES that an examiner
must provide reasons and/or examples to support conclusions. The
examiner has never stated that there would be a serious burden on
the examiner if restriction were not required. Indeed, there
should be no serious burden on the examiner. The examiner in
this case is well skilled in examining cell healing devices in
Class 607, and particularly the apparatus in Subclasses 1, 2, 50,
and the method in Subclass 50. Therefore it is believed that no
difficult search is required because the examiner is well-versed
in Class 607 and there should not be any undue burden for the

search. Therefore restriction should not be required.

With regard to the examiner's specific points, in the following paragraphs it can be seen that restriction is not proper:

Groups I, II, and III are not distinct inventions.

Claim 42, for example, is ^{but not exactly similar} substantially similar to Claim 1.

Both groups result from a single inventive effort. The

*no
it
doesn't* apparatus as claimed in claim 1 sets forth the details of the sub-combination of claims 42-83. The two-way

*It has
is seen in
the restriction* distinctiveness required by 806.05(c) cannot be established.

The combination as claimed requires the sub-combination as

*no
it
doesn't* claimed. There is no separate classification, status or field of search as required by 806.05(c), because subclass 50, which is noted by the examiner for Group II, is simply an indented subclass of Class 607, which is noted by the examiner for Group I. Both subclasses would have to be examined in both cases.

Inventions I, II, III and IV are related because they all require the structure of Group I, II and III claims, and they all use the process of Group IV claims. The inventions of Groups I, II, and III are not different combinations in that they do not have "different modes of operation" as required by 806.04. Moreover, where inventions are related

*show
that
2nd
3rd* as disclosed but are not distinct as claimed, restriction is never proper (MPEP 806). Moreover, there is no serious burden on the examiner because Subclasses 1, 2, and 50 are

both indented subclasses under Class 607, and both inventions I, II, III, and IV are classified together in the same single Class, 607.

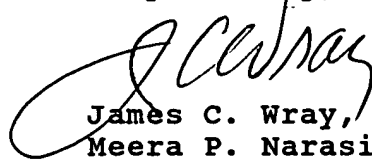
MPEP 806 provides that if the inventions are not distinct as claimed, restriction is never proper. The process as claimed in Group IV claims is not distinct from the device claimed in the claims of Groups I, II, III. For example, the process as claimed in claim 58 (Group IV) is the result of the device as claimed in claim 1 (Group I), claim 42 (Group II) and claim 50 (Group III). Section 806.05(h) emphasizes "as claimed" and falls under the cautions of 806 and 806.05, both of which state, "where the inventions are related as disclosed but are not distinct as claimed, restriction is never proper".

In the present case the particular criteria and guidelines of 803 must be followed in that there must be a serious burden on the examiner if restriction were not required. In the present case, all of the groups must be searched in all of the subclasses which the examiner has pointed out. All are properly classified and searched together, and the search for one group would not be complete without searching all of the subclasses that the examiner has pointed out. In fact, there is no showing why there will be undue burden, particularly when all the claims fall under the same Class, and particularly when the Group II and Group IV claims fall under the same Class and same Subclass.

For the above reasons, Applicant believes that all the claims, 1-83, should be examined together.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

Respectfully,

A handwritten signature in black ink, appearing to read 'J C Wray', is written over the typed name of James C. Wray.

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June 10, 2002